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In re Application of :
NAKAMURA et al. :
Application No.: 10/528,069 : DECISION
PCT No.: PCT/JP03/12353 :
Int. Filing Date: 26 September 2003 :
Priority Date: 27 September 2002 :
Attorney Docket No.: 122733 :
For: THERMAL TREATMENT APPARATUS, :
METHOD FOR MANUFACTURING :
SEMICONDUCTOR DEVICE, AND METHOD :
FOR MANUFACTURING SUBSTRATE :

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 07 October 2005 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 26 September 2003, applicants filed international application PCT/JP03/12353, which designated the United States and claimed a priority date of 27 September 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 08 April 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 28 March 2005 (27 March 2005 being a Sunday).

On 15 March 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a translation of the application into English.

On 26 August 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required.

On 07 October 2005, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration of inventors, a copy of a letter sent to non-signing inventor Mr. Shimada on April 6, 2005 and an English translation thereof, a copy of a letter sent

to Mr. Shimada on May 23, 2005 and an English translation thereof, and copies of two certified mail receipts and English translations thereof.

DISCUSSION

Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the petition fee is \$200 rather than \$130. The balance of \$70 has been charged to Deposited Account 15-0461. Accordingly, item (1) has been met.

Item (3) and (4) have been met as well.

Item (2) has not been met. As noted in MPEP § 409.03(d), the statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Here, it is not clear that Mr. Daniel Tanner has firsthand knowledge of the facts recited in the statement by him. Statements based on hearsay will not normally be accepted. Also, it is not clear whether it is being alleged that Mr. Tomoharu Shimada refuses to execute the application or that he cannot be reached after diligent effort. A communication was sent to Mr. Shimada's last known address on 06 April 2005 and on 23 May 2005. It is not clear whether Mr. Shimada resided at this address at the time. Accordingly, it is not clear if the inventor is no longer at this address and his whereabouts are unknown, or if he simply received the mailings and did not respond. If the mailings were received and the inventor did not respond, then a refusal to execute the application would likely need to be established. The mailings could be followed up with a telephone call to determine Mr. Shimada's intent. If it is being alleged that the inventor cannot be reached or found, copies of documentary evidence such as *internet searches*, certified mail return receipts, cover letters of instructions, and telegrams, that support a finding that the non-signing inventor could not be found or reached should be made part of the affidavit or declaration.

Translation

Applicants have not yet submitted an accurate translation of the international application as filed. In the translation filed 15 March 2005, a translation of the Figures was not provided. Unless the expression "Fig." is used to identify the drawing(s) in the international application as filed, the expression used to identify the drawing(s) must be translated. See PCT Rule 49.5(f). In the submission filed 15 March 2005, no such translation was provided.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response, including a translation of the Figures, must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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